

REMARKS / ARGUMENTS

Claims 1-2, 4-6, 8, 12, 14, and 16-20 remain pending in this application. No claims have been canceled or added.

Interview

Applicants wish to thank the Examiner and the Examiner's supervisor for conducting an interview with the undersigned and Applicants' representatives on October 21, 2009. As indicated in the Interview Summary provided to the undersigned at the conclusion of the interview, the Examiner agreed with respect to the references and the background portion of the specification and indicated that he would update his search and consider the substance of the interview before responding.

It is pointed out to the Examiner that the continuation sheet attached to the Interview Summary that was mailed on October 23, 2009, is not the same as the personal copy provided to the undersigned at the conclusion of the interview on October 21, 2009. In particular, the continuation sheet mailed on October 23, 2009 states that "the counterfeit and initial bank note images are extracted using the same sensor and are compared inside the ATM" and was initially prepared by the Examiner for review and approval during the interview.

However, as explained to the Examiner during the interview, such language is not used in the claims and was not argued as a reason for patentability during the interview. Instead, claim 1, for example, recites: "An automatic teller machine (ATM) electronically connected to one or more devices, the one or more devices comprising: a deposit device configured to receive an initial bank note and a counterfeit bank note which is physically the same bank note after having been identified as a counterfeit bank note at an external station; an image extraction device configured to extract one or more initial images from the initial bank note and one or more images from the counterfeit bank note...". It was also pointed out to the Examiner that previously pending claims included the word "sensor" which may have caused some confusion for the Examiner.

Consequently, the continuation sheet was corrected by the Examiner to remove the language "the counterfeit and initial bank note images are extracted using the same sensor and are compared inside the ATM" in order to more accurately reflect that which was discussed during the interview. The Interview Summary (including continuation sheet) personally given to the undersigned after the interview on October 21, 2009 is attached as Exhibit A. It is hereby requested that the Examiner acknowledge that the attached Interview Summary (Exhibit A) includes the continuation sheet agreed upon during the interview and that the continuation sheet mailed on October 23, 2009 was not the continuation sheet agreed upon

during the interview and was inadvertently attached to the Interview Summary mailed on October 23, 2009.

The following includes the substance of that which was discussed during the interview.

35 U.S.C. §112

Claim 1 has been amended to overcome the Examiner's rejection under this section.

35 U.S.C. § 103

Claim 12 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Background of Specification and Fig. 1 in view Giesecke et al ("PIDSY® Post Identification System"). Claims 14-18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Background of Specification and Fig. 1 in view Giesecke et al and further in view of ProCashin ("ProCashin/Signature for § 36 BbankG"). Claims 1-6, 8 and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Background of Specification and Fig. 1 in view Giesecke et al and further in view of Jones et al (U.S. Pub. No. 2003/0059098). Claim 19 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Background of Specification and Fig. 1 in view Giesecke et al and further in view of Onishi et al (U.S. Pub. No. 2002/0136457). These rejections are traversed as follows.

As explained during the interview, the prior art does not disclose "a deposit device configured to receive an initial bank note and a counterfeit bank note which is physically the same bank note after having been identified as a counterfeit bank note at an external station" and "an image extraction device configured to extract one or more initial images from the initial bank note and one or more images from the counterfeit bank note" (claim 1) or that "the steps of extracting one or more initial images from the initial bank note and extracting one or more subsequent images from the counterfeit bank note are carried out using the same image extraction device" (claim 12). The prior art also does not disclose "a comparison device configured to compare the one or initial images of the initial bank note to the one or more images of the counterfeit bank note in order to obtain a comparison result, the comparison device being configured to calculate values indicating a degree of similarity between the initial bank note and the counterfeit bank note as said comparison result" (claim 1) or "comparing the one or more initial images of the initial bank note to the one or more subsequent images of the counterfeit bank note by calculating values indicating a degree of similarity between the initial bank note and the counterfeit bank note in order to obtain a comparison result" (claim 12).

As also explained to the Examiner during the interview, the background section of the present application merely states that once a note is found to be counterfeit, its serial number is read out from a cartridge memory at the bank branch office where it was initially deposited. In this regard, Applicants wish to point out a

typographical error in a response filed on March 16, 2009 with respect to the Background portion of the present specification. The response filed March 16, 2009 recites, on page 11, line 4, that "this process does show 'using the same image extraction device'." However, this phrase should have correctly stated that "this process does **not** show 'using the same image extraction device'."

The deficiencies in the background section of the present specification are not overcome by resort to any of the remaining references. Furthermore, as mentioned during the interview, Giesecke et al and ProCashin are not believed to be prior art. Enclosed is a Preliminary Opinion of the Opposition Division of the EPO (Exhibit B) as well a Decision of the Opposition Division of the EPO (Exhibit C) from an Opposition Proceeding in the European Patent Office (EPO) which indicate that Giesecke et al and ProCashin were not shown to be prior art. With respect to Giesecke et al, the Examiner's attention is directed to Section B.3.1.2 on pages 12-13 of the Decision (Exhibit C). With respect to ProCashin, the Examiner's attention is directed to Section B.7.3 on page 4 of the Preliminary Opinion (Exhibit B) and Section A.6.1 on page 3 of the Decision (Exhibit C).

Giesecke et al and ProCashin were cited by Applicants in an Information Disclosure Statement, filed on December 7, 2007, because they were cited by Opposers in the Opposition Proceeding in the EPO. However, as clearly stated in MPEP §2129, the "mere listing of a reference in an Information Disclosure Statement is not taken as an admission that the reference is prior art against the claims."

Therefore, the listing of Giesecke et al and ProCashin in the Information Disclosure Statement filed on December 7, 2007 should not be taken as an admission that they are prior art against the claims.

Nevertheless, even if Giesecke et al and ProCashin were considered to be prior art against the claims, the pending claims would still be patentable over all of the prior art of record including Jones et al and Onishi et al, whether taken individually or in combination, because the presently claimed combination is neither disclosed nor suggested by such prior for at least the reasons set forth above. The Examiner is hereby invited to contact the undersigned by telephone with any questions in order to expedite prosecution of this application.

Conclusion

In view of the foregoing, Applicants respectfully request that a timely Notice of Allowance be issued in this case. Please charge any shortage of fees due in connection with the filing of this paper, or credit any overpayment of fees, to Deposit Account 50-1417.

Respectfully submitted,

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